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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,091	08/27/2003	Anthony J. Baerlocher	0112300-1411	4932
7590 12/24/2008 Bell, Boyd & Lloyd LLC P.O. Box 1135 Chicago, IL 60690-1135				
EXAMINER				
HOEL, MATTHEW D				
ART UNIT		PAPER NUMBER		
3714				
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12/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/649,091

Applicant(s)

BAERLOCHER, ANTHONY J.

Examiner

Matthew D. Hoel

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-41, 43-61, 64-76, 78-93, 103, 117, 121, 125 and 126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-41, 43-61, 64-76, 78-93, 103, 117, 121, 125 and 126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/04/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 to 16, 19 to 41, 43 to 61, 64 to 76, 78 to 93, 103, 117, 121, 125, and 126 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Independent Claim 1 does not meet 101 eligibility under the recent Bilski decision because there is no transformation of a composition of matter from one form to another or the gaming device is claimed in terms of functionality, but this functionality is not sufficiently tied to an apparatus, such as by the functionality being carried out by specific structure of the apparatus. There is no mention of the first and second pluralities of awards associated with the respective first and second award symbols being displayed on a screen to a player or being displayed on a payable. There is no mention of the first activatable symbol indicators or the second activatable symbol indicators being displayed on a screen to a player. No mention is made of the first and second symbol indicators moving relative to the award indicator on a screen visible to the player. No mention is made of the player using an input device such as buttons, a mouse, a keyboard, or a touchscreen to activate the first symbol indicator or the second symbol indicator. No mention is made of indicating one of the first award symbols on the award indicator or indicating one of the second award symbols on the award

indicator in a format visible to a player such as a display screen. There is no mention of providing the total award to the player via a coin hopper, a bill slot, or via a card reader/writer to a player tracking card available to the player. The claim is almost a method claim except that processor and gaming device are each cited once. There is no citation of accepting input from a player via an input device on a gaming device, manipulating that data in physical memory by a physical processor of the gaming device according to the rules of the game to provide a game outcome, displaying the outcome of the game to the player via an output device on the gaming device, or providing an award to a player via a coin hopper, bill slot, or card reader/writer on the gaming device in the event that the player obtains a winning outcome. Such limitations would serve to tie the cited executed steps to an apparatus by citing, for example, which steps are executed by which structure of the apparatus. Page 10 of the Bilski decision requires claims to be tied to a particular machine or apparatus or transform a particular article into a different state or thing.

4. Similarly, independent Claim 28 does not cite displaying via a display device on a gaming machine a plurality of award indicators including a plurality of first award symbols and a plurality of second award symbols; a plurality of first activatable symbol indicators adjacent to the first award symbols of the award indicators; a plurality of second activatable symbol indicators positioned adjacent to the second award symbols of the award indicators, wherein the first and second symbol indicators are movable relative to the award indicator. Claim 28 does not cite that the symbol indicators are activatable by a player via an input device on the gaming device. Claim 28 does not

cite a plurality of awards associated with the first award symbols or a plurality of second awards associated with the second award symbols being displayed to the player via a payable or an output display such as a screen on a gaming device. Claim 28 does not cite, via an input device on a gaming device, enabling a player to select at least one of the first symbol indicators to activate the picked award symbol indicator, or enabling the player to select at least one of the second symbol indicators to activate the picked second symbol indicator. Claim 28 does not cite, by an output device such as a display on a gaming device, causing any activated first symbol indicators to indicate the first award symbols, or causing any activated second symbol indicators to indicate the second award symbols to the player. Claim 28 does not cite, via a coin hopper, bill slot, or player tracking card reader/writer, providing a total award to a player based on the first and second awards associated with the indicated first and second award symbols.

5. Independent Claims 47 and 103 have similar 101 deficiencies as Claims 1 and 28 as they only cite a gaming device comprising a processor, with the rest of the structure being defined by functionality or method steps without sufficiently citing how these steps are carried out by gaming device features or by what gaming device structures are carrying out these steps.

6. Independent method Claims 57, 72, 84, 117, and 121 only cite methods of operating a gaming device without citing how the methods are carried out by gaming device limitations or structures or by citing exactly which gaming device features or structures carry out these method steps. Claim 57, for example, does not cite displaying, via a screen or output device on a gaming device, an award indicator

including a plurality of first award symbols and a plurality of second award symbols to a player, wherein a plurality of first awards are associated with the first award symbols and a plurality of second awards are associated with the second award symbols. No citation is made of displaying the first and second awards to the player by a payable or an output device such as a screen on a gaming device. No citation is made of enabling, via an input device such as a touchscreen, buttons, keyboard, or mouse on a gaming device, enabling the player to pick one of a plurality of first symbol indicators positioned adjacent to the first award symbols, or similarly enabling the player to pick one of the plurality of second symbol indicators adjacent to the second award symbols. No citation is made, such as by a screen on a gaming device, of activating the first and second symbol indicators, moving the first and second symbol indicators while the award indicator remains stationary, indicating one of the first award symbols with the activated first symbol indicator, or indicating one of the second award symbols with the activated second symbol indicator. No citation is made of, via a coin hopper, bill slot, or player tracking card reader/writer, of providing a total award to the player based on the first and second awards associated with the indicated first and second award symbols on the award indicators. There is no citation of accepting input from a player via an input device on a gaming device, manipulating that data in physical memory by a physical processor of the gaming device according to the rules of the game to provide a game outcome, displaying the outcome of the game to the player via an output device on the gaming device, or providing an award to a player via a coin hopper, bill slot, or card reader/writer on the gaming device in the event that the player obtains a winning

outcome. Such limitations would serve to tie the cited executed steps to an apparatus by citing, for example, which steps are executed by which structure of the apparatus. Page 10 of the Bilski decision requires claims to be tied to a particular machine or apparatus or transform a particular article into a different state or thing. The other independent method claims suffer similar deficiencies as Claim 57, as they are worded similarly.

Response to Arguments

7. Applicant's arguments with respect to claims 1 to 16, 19 to 41, 43 to 61, 64 to 76, 78 to 93, 103, 117, 121, 125, and 126 have been considered but are moot in view of the new ground(s) of rejection. The Bilski decision has come out since the last office action. The previous 112 rejections are withdrawn as the applicant has properly amended the claims. There are no prior art rejections made at this time. After updating the search and the interview with primary Scott Jones on 5-9-2007, the examiner believes that the claims are allowable over prior art as of the time of invention as they all cite the activatable symbol indicators being moved relative to the award indicator. Claims 1-17, 19-41, 43-61, 64-76, 78-93, 103, 117, 121, 125, and 126 (07-18-2007) had previously been allowed because of this. The other claims without the movable symbol indicators have since been cancelled by the applicant. The examiner believes the novel combination of features to be a) the plurality of first activatable symbol indicators associated with the first award symbols and the plurality of second activatable symbol indicators associated with the second activatable award symbols, b) enabling the player

to activate one of the first symbol indicators and one of the second award indicators, c) the first and second symbol indicators moving relative to the award indicator, and d) providing the total award to the player. All of the independent claims have this same combination of features. The closest art the examiner can find is Kelly, et al. (U.S. patent 5,584,763 A) and Pau, et al. (U.S. pre-grant publication 2002/0042294 A1). Neither reference has plural separately activatable symbol indicators that move relative to the award indicator.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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